

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM S. MILLER

Appeal No. 96-1490
Application 08/135,833¹

ON BRIEF

Before THOMAS, MARTIN, and LEE, Administrative Patent Judges.
MARTIN, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision in an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 4-7 and 10-12 over prior art. Claims 2, 3, 8, and 9 have been canceled and claims 13-16 stand withdrawn from consideration. No claims have been allowed. We reverse.

Application for patent filed October 13, 1993.

The invention relates to a telecommunication device (e.g., a facsimile unit) including a display panel and a keyboard having an Undo key. In addition to the normal function of canceling the immediately previous keyboard instruction, the claimed Undo key performs the following functions: (a) when the effect of one or more immediately prior actions was to shift the cursor to a character position other than the last displayed character position, a single operation of the Undo key causes the cursor to move to the last displayed character position; and (b) a subsequent operation of the Undo key with the cursor in the last displayed character position causes that character to be deleted and the cursor to move back one position.

Apparatus claim 1 reads as follows:

1. A telecommunication unit including an operator panel with a keyboard and a display panel, said operator panel including a key designated Undo, said telecommunication unit comprising:

processor means responsive to a user actuation of said key designated Undo, to reverse at least an immediately previous user-commanded action and to cause said telecommunication unit to manifest a state in existence just prior to said immediately previous operator-commanded action, and if said immediately previous user-commanded action results in a displayed cursor on said display panel being located at any character position within a name or number field which is other than a last displayed character in said name or number field, said processor means responds to actuation of said key designated Undo by moving said

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cursor to said last displayed character position in said name or number field, in lieu of causing said telecommunication unit to manifest a state in existence just prior to said immediately previous operator commanded action, said processor means responding to a repeat action of said key designated Undo by removing a character displayed at a character position at which said cursor is located and moving said cursor back one character position in said display panel.

Claim 7, which is the only other independent claim, recites the same limitations in method format.

The references relied on by the examiner in the Answer are:

Kobayashi	4,833,705	May 23, 1989
Kaufman et al (Kaufman)	5,173,854	Dec. 22, 1992
DeAguiar et al (DeAguiar)	5,263,136	Nov. 16, 1993 (filed Apr. 30, 1991)
Hahn et al (Hahn)	5,307,452	Apr. 26, 1994 (filed Sep. 21, 1990)

"The World's First Desktop Office is Here" (Canon, Inc., publication No. PUB.S-CE-059, 1990) (the Canon article)

Claims 1, 4-7, and 10-12 stand rejected under 35 U.S.C. § 103 as alternatively unpatentable over:

(a) the Canon article; and

(b) Kobayashi in view of any one of Kaufman, Hahn, and DeAguiar.²

The Canon article discloses a desktop workstation with facsimile capability that includes a display device and a keyboard having an UNDO key that "Undoes a function" (see penultimate page). No other information about UNDO key operation is disclosed. The examiner contends it would have been obvious to program this UNDO key to perform functions performed by other known function keys, including an "End" key, which causes the cursor to move to the last displayed character position, a "Delete" key, which removes the character displayed at the cursor position, and a "Space Bar" key, which allegedly will cause the cursor to move "back" one character position (Answer at 4-5). Why the examiner states that operation of the Space Bar key will cause the cursor to move back one character position is not understood. Operation of a Space Bar key typically moves the cursor forward one character position at a time, whereas operation of a Backspace key moves the cursor back one character

² In the final Office action (at 4) the examiner additionally rejected claims 1, 3-7, and 9-12 under § 103 as unpatentable over references to Ishii and Chen. This ground of rejection was not repeated in the Answer and is therefore treated as withdrawn.

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position at a time. However, even assuming a Space Bar key causes backward cursor movement, we agree with appellant that the examiner's proposed combination of teachings is improperly based on hindsight. As explained in In re Napier, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995),

"[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." In re Bond, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990) (quoting Carella v. Starlight Archery and Pro Line Co., 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986)). However, the "suggestion to modify the art to produce the claimed invention need not be expressly stated in one or all the references used to show obviousness." Cable Elec. Prods., Inc. v. Genmark, Inc., 770 F.2d 1015, 1025, 226 USPQ 881, 886 (Fed. Cir. 1985). Rather, the test is whether the combined teachings of the prior art, taken as a whole, would have rendered the claimed invention obvious to one of ordinary skill in the art. See In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

The examiner has not explained, and it is not apparent to us, why the artisan, absent the guidance provided by appellant's disclosure and claims, would have been motivated to combine the functions of the prior art Undo, Delete, End, and Space Bar keys into one key in a manner that satisfies the requirements of claims 1 and 7. More particularly, the examiner has not explained why the artisan would have been motivated to make the

Canon article's UNDO key function in the manner of an "End" key when the cursor is at a position other than the last character position and, when operated again, to delete the displayed last character and move the cursor back one position. As a result, we will not sustain the rejection of any of the appealed claims over the Canon article.

Turning now to the second ground of rejection, Figure 4 of Kobayashi, the principal reference, shows a communication console 40 including a display device 42 and a keyboard portion 47, which does not include an Undo key. As evidence of the obviousness of providing Kobayashi's console with an Undo key, the examiner alternatively relies on the Undo keys disclosed in Kaufman (col. 6, line 63 to col. 7, line 2), Hahn (col. 11, lines 1-14), and DeAguiar (col. 23, lines 3-31 and col. 27, lines 60-63). However, as none of the Undo keys disclosed in these references perform the claimed functions, the examiner again argues that it would have been obvious to use the Undo key to perform the functions of a known End, Delete, and Space Bar keys. This rejection accordingly fails for the same reason as the rejection based on the Canon article, i.e., the absence of any apparent motivation to combine the teachings in a manner that satisfies the requirements of the claim.

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REVERSED

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